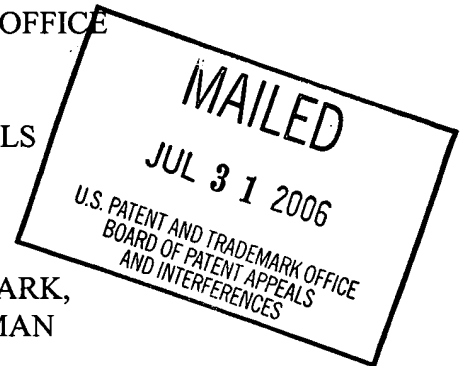


The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RICHARD J. NEELY, DARRYL F. CLARK,
KURTIS L. BROWN and MICHAEL T. MORMAN



Appeal No. 2006-0795
Application 09/165,034

ON BRIEF

Before WARREN, KRATZ and FRANKLIN, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

Decision on Appeal

This is an appeal under 35 U.S.C. § 134 from the decision of the examiner finally rejecting claims 1 through 7, 9 through 12, 14 through 16, 27 through 50 and 59 through 78, all of the claims in the application.

Claim 1 illustrates appellants' invention of a nonwoven web, and is representative of the claims on appeal:

1. A nonwoven web made from fibers, the fibers comprising thermoplastic fibers, said nonwoven web having a first end and a second and opposite end, said nonwoven web defining a first area having a first basis weight and a second area having a second basis weight being located on said nonwoven web according to a predetermined pattern, said first basis weight being at least about 1.5 times greater than said second basis weight, said first area comprising from about 25% to about 75% of said nonwoven web, the web being compressed and thermally bonded together.

The references relied on by the examiner are:

| | | |
|--------------------------|-----------|---------------|
| Karami | 4,027,672 | Jun. 7, 1977 |
| Alemaný et al. (Alemany) | 4,834,735 | May 30, 1989 |
| Newkirk et al. (Newkirk) | 5,143,779 | Sep. 1, 1992 |
| Morman | 5,611,879 | Mar. 18, 1997 |

Appellants rely on the following references:

| | | |
|--------------------------------------------------------------------------|-----------|---------------|
| Weisman et al. (Weisman '402) | 4,673,402 | Jun. 16, 1987 |
| Weisman et al. (Weisman '042) (published European Patent Application) | 0 122 042 | Oct. 10, 1984 |

The examiner has advanced the following grounds of rejection on appeal:

claims 1, 2, 7, 9, 10, 15, 16, 27 through 32, 34, 35, 38 through 44, 49, 50 and 62 through 76 stand rejected under 35 U.S.C. § 103(a) as being obvious over Alemany in view of Newkirk (answer, pages 3-5);¹

claims 3 through 6, 11, 33, 48, and 59 through 61 stand rejected under 35 U.S.C. § 103(a) as being obvious over Alemany in view of Newkirk as applied to claims 1, 27 and 35 above and further in view of Karami (answer, pages 5-6); and

claims 12, 14, 36, 45 through 47, 77 and 78 stand rejected under 35 U.S.C. § 103(a) as being obvious over Alemany in view of Newkirk as applied to claims 1, 27 and 35 above and further in view of Morman (answer, page 6).

Appellants argue the claims of each ground of rejection as a group and rely on the arguments submitted with respect to the first ground of rejection in traversing the second and third grounds of rejection (brief, pages 4-7, 7-8 and 8). Thus, we decide this appeal based on appealed claims 1 as representative of appellants' groupings of claims with respect to the first ground of rejection and of appellants' arguments with respect to the second and third grounds of rejection. 37 CFR § 41.37(c)(1)(vii) (September 2004).

We affirm.

We refer to the answer and to the brief for a complete exposition of the positions advanced by the examiner and appellants.

¹ We have not considered Cook et al. which the examiner cites under "Evidence Relied Upon" and in argument (answer, pages 3 and 8) because this reference is not included in the statement of any of the grounds of rejection. *See In re Hoch*, 428 F.2d 1341, 1342 n. 3, 166 USPQ 406, 407 n.3 (CCPA 1970); *cf. Ex parte Raske*, 28 USPQ2d 1304, 1304-05 (Bd. Pat. App. & Int. 1993).

Opinion

We have carefully reviewed the record on this appeal and based thereon find ourselves in agreement with the supported position advanced by the examiner that, *prima facie*, the claimed nonwoven web encompassed by appealed claim 1 would have been obvious over the combined teachings of Alemany and Newkirk to one of ordinary skill in this art at the time the claimed invention was made. Accordingly, since a *prima facie* case of obviousness has been established by the examiner, we again evaluate all of the evidence of obviousness and nonobviousness based on the record as a whole, giving due consideration to the weight of appellants' arguments in the brief and reply brief. *See generally, In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984).

We agree with the examiner's findings of fact from the references and conclusions of law based on this substantial evidence as set forth in the answer, to which we add the following for emphasis.

The principal issue in this appeal involves the language of claim 1 specifying that "the [nonwoven] web being compressed and thermally bonded together." There is no claim limitation specifying the extent to which the nonwoven web is thermally bonded together and appellants do not provide any guidance in this respect, such as a specific meaning for the term "bonded," in the written description in the specification (e.g., page 11, ll. 6-13, and page 12, ll. 21-31). Thus, all that claim 1 requires is that the nonwoven web must be thermally bonded to some extent, however small. *See, e.g., In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364, 70 USPQ2d 1827, 1830 (Fed. Cir. 2004); *In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997); *In re Zletz*, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989).

We cannot agree with appellants that the Weisman references would have taught away from thermally bonding the nonwoven web (brief, pages 5-6). As appellants point out, Weisman '042 would have disclosed a "substantially unbonded" nonwoven web and that "[a] large number of bonds . . . would seriously impair" the ability of the web in its intended use (e.g., page 5, l. 28, to page 6, l. 12). However, we find that Weisman '042 also would have disclosed that some bonding occurs and "some modest degree of bonding does not appear to negatively affect the"

nonwoven web which further contains hydrogel particles and is used as a storage layer in an absorbent structure (*id.*). We further find that Weisman '402 incorporates by reference Weisman '042 for the procedure of forming a nonwoven web comprising "substantially unbonded fibers" and hydrogel particles (e.g., col. 8, ll. 23-33).

While appellants point out that Alemany incorporates by reference Weisman '042 and a Weisman United States Patent application an offspring of which matured into Weisman '402, we find that Alemany cites these documents with respect to hydrogel particles in nonwoven webs and as disclosing "[p]referably" a storage structure based thereon, "although other high capillarity structures may also be used" (col. 1, ll. 28-44, and col. 13, ll. 44-52). Thus, neither Alemany nor the Weisman patent documents would have criticized, discredited or otherwise discouraged bonding the nonwoven web of Alemany as would have been suggested by Newkirk as the examiner contends. *See generally, In re Kahn*, 441 F.3d 977, 985-89, 78 USPQ2d 1329, 1334-38 (Fed. Cir. 2006) ("A reference may be said to teach away when a person of ordinary skill, upon reading the reference would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant." (quoting *In re Gurley*, 27 F.3d 551, 553 [31 USPQ2d 1130, 1131] (Fed. Cir. 1994))); *In re Fulton*, 391 F.3d 1195, 1201, 73 USPQ2d 1141, 1145-46 (Fed. Cir. 2004) (prior art "disclosure does not criticize, discredit, or otherwise discourage the solution claimed").

Instead, we determine that the disclosure in Alemany provided by the incorporated by reference Weisman patent documents would have suggested to one of ordinary skill in this art that the nonwoven webs disclosed by Alemany can be bonded to the extent that the nonwoven web is not negatively affected for its intended purpose. Thus, this disclosure alone supports the examiner's position. *See In re Hedges*, 783 F.2d 1038, 1039-40, 228 USPQ 685, 686 (Fed. Cir. 1986) ("In Hedges' case the Solicitor referred to new portions of the references cited by Hedges during examination for further support of the same rejection that had been upheld by the Board. Hedges had relied on these references before the Board, as he does before us, for his argument that viewed as a whole the body of the prior art teaches away from conducting this reaction at high temperatures. The Solicitor should not be constrained from pointing to other portions of these same references in contravention of Hedges' position.").

Appellants further contend that Newkirk would have disclosed “webs that are not used as absorbent layers, but, instead, are used as coverstock or as spacer fabrics in absorbent personal care products” such as diapers (brief, page 7). Pointing to the difference in the liquid transport properties of a coverstock layer and a spacer layer taught by Newkirk and the absorption properties of an absorbent layer taught by Alemany, appellants submit that “it would not have been obvious to replace the substantially unbonded, air-laid absorbent member disclosed in [Alemany] with the coverstock or spacer fabric disclosed in [Newkirk], or “to replace apply the bonding process disclosed in [Newkirk] to the unbonded absorbent member disclosed in [Alemany],” particularly in view of the disclosure of the Weisman references (*id.*). The examiner finds that the absorbent member of Alemany (col. 2, ll. 12-20) provides similar properties acquisition properties as the nonwoven web coverstock and spacer layers of Newkirk in the same kind of products (answer, page 7).

On this record, we agree with the examiner that one of ordinary skill in this art would have found in Alemany and Newkirk the reasonable suggestion to combine the teachings thereof to arrive at modifying the nonwoven web of Alemany by compressing and air-bonding the same as taught by Newkirk in the reasonably expectation of obtaining a nonwoven web that can be used in the same absorbent products as taught by both references. The combined teachings of Alemany and Newkirk provide substantial evidence supporting this position because Alemany would have disclosed that bonding can be used in nonwoven webs for storage layers that can acquire liquid (e.g., col. 13, ll. 37-52), and Newkirk would have suggested bonding nonwoven webs for use in acquisition layers that can be used with storage layers (e.g., col. 1, ll. 5-60, and col. 3, l. 65, to col. 4, l. 41). The fact that the use of the nonwoven webs of Alemany is not coincident with the use of the nonwoven webs of Newkirk does not require a different result. *See In re Keller*, 642 F.2d 413, 425-26, 208 USPQ 871, 881-82 (CCPA 1981)(“The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art.”).

As we noted above, appellants rely on the same arguments considered here with respect to the grounds of rejection further including Karami and Morman, respectively.

Accordingly, based on our consideration of the totality of the record before us, we have weighed the evidence of obviousness found in the combined teachings of Alemany and Newkirk and as further combined with each of Karami and Morman with appellants' countervailing evidence of and argument for nonobviousness and conclude that the claimed invention encompassed by appealed claims 1 through 7, 9 through 12, 14 through 16, 27 through 50 and 59 through 78 would have been obvious as a matter of law under 35 U.S.C. § 103(a).

The examiner's decision is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv) (2005).

AFFIRMED

Charles E. Warren
CHARLES E. WARREN

CHARLES F. WARREN
Administrative Patent Judge

Peter F. Krebs

PETER F. KRATZ
Administrative Patent Judge

Beverly A. Frankston

BEVERLY A. FRANKLIN
Administrative Patent Judge

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